

AF IRW



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Before the Board of Patent Appeals and Interferences

Applicant : Carolynn Rae Johnson
Serial No. : 09/742,621
Filed : December 21, 2000
For : DEDICATED CHANNEL FOR DISPLAYING PROGRAMS
Examiner : James R. Sheleheda
Art Unit : 2617

APPEAL BRIEF

May It Please The Honorable Board:

This is Appellants' Brief on Appeal from the final rejection of claims 1, 2, 5-9 and 12-20. Please charge the \$500.00 fee for filing this Brief to Deposit Account No. 07-0832. Appellants waive an Oral Hearing for this appeal.

Please charge any additional fee or credit overpayment to the above-indicated Deposit Account. Enclosed is a single copy of the Brief.

I. REAL PARTY IN INTEREST

The real party in interest of Application Serial No. 09/742,621 is the Assignee of record:

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II. RELATED APPEALS AND INTERFERENCES

There are currently, and have been, no related Appeals or Interferences regarding Application Serial No. 09/742,621 known to the undersigned attorney.

III. STATUS OF THE CLAIMS

Claims 1, 2, 5-9 and 12-20 are rejected; claims 3-4 and 10-11 are canceled. The rejections of claims 1, 2, 5-9 and 12-20 are appealed.

IV. STATUS OF AMENDMENTS

All amendments were entered and are reflected in the claims included in Appendix I. No amendment was filed subsequent to final rejection.

V. SUMMARY OF CLAIMED SUBJECT MATTER

This summary sets forth exemplary reference characters and pages and line numbers in the specification where an embodiment of each separately argued claim is illustrated or described. The identification of reference characters and pages and line numbers does not constitute a representation that any claim element is limited to the embodiment illustrated at the reference character or described in the referenced portion of the specification.

Independent claim 1 claims a method of processing program guide information, comprising the steps of:

recording viewing statistics based on topics (page 3, lines 29-34; 210)

entering user processing request information (page 5, lines 11-13; 701-703);

processing program guide information based on entered user processing request information and the viewing statistics (page 5, lines 13-15; 701); and

displaying processed result, matching the topics in the recorded viewing statistics, in a dedicated channel (page 5, lines 27-29; 701), wherein the processed result includes at least two programs in a first time slot, only one of the at least two programs is displayed in the first time slot under the dedicated channel, and others of the at least two programs are also displayed under the dedicated channel directly in response to highlighting the only one of the at least two programs (page 7, lines 9-12; 1302).

Dependent claim 6, in addition to the limitations of claim 1, contains the limitation that the step of entering user processing request information comprises selecting a search of program guide information based on user-entered text (page 6, lines 19-26; 1003).

Independent claim 8 claims a system for processing program guide information, comprising:

a user controller (page 9, lines 31-33; 450R) for entering user processing request information (page 5, lines 11-13; 701-703);

a microprocessor (page 9, lines 34-35; 415R) for recording viewing statistics based on topics (page 3, lines 29-34; 210) and for processing program guide information based on entered user processing request information and the viewing statistics (page 5, lines 13-15; 701); and

said microprocessor causing the processed result, matching the topics in the recorded viewing statistics, to be displayed in a dedicated channel, wherein the processed result includes at least two programs in a first time slot, only one of the at least two programs is displayed in the first time slot under the dedicated channel, and others of the at least two

programs are also displayed under the dedicated channel directly in response to highlighting the only one of the at least two programs (page 7, lines 9-12; 1302).

Dependent claim 13 depends from claim 8 and adds the limitation that the entered user processing request information comprises a request for a search of program guide information based on user-entered text (page 6, lines 19-26; 1003).

Dependent claim 17 depends directly from claim 14, and indirectly from independent claim 8, and adds to independent claim 8 the limitations that the dedicated channel is always displayed at a predefined position in the program guide (page 6, lines 13-15; Fig. 8).

Dependent claim 20 adds to dependent claim 7 the limitation that the dedicated channel is always displayed at a predefined position in the program guide (page 6, lines 13-15; Fig. 8).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The Examiner has rejected claims 1, 2, 5, 7-9, 12 and 14-20 as being unpatentable under 35 USC 103(a) over Wehmeyer (U.S. Patent No. 5,867,226), in view of Arai, et al. (U.S. Publication No. 2002/0073425) and Arsenault et al. (U.S. Patent No. 6,925,650).

The Examiner has rejected claims 6 and 13 as being unpatentable under 35 USC 103(a) over Wehmeyer (U.S. Patent No. 5,867,226), in view of Arai, et al. (U.S. Publication No. 2002/0073425), Arsenault et al. (U.S. Patent No. 6,925,650) and Schein (U.S. Patent No. 6,133,909).

VII. ARGUMENT

Rejection of Claims 1, 2, 5, 7-9, 12 and 14-20 as being unpatentable under 35 USC 103(a) over Wehmeyer (U.S. Patent No. 5,867,226), in view of Arai, et al. (U.S. Publication No. 2002/0073425) and Arsenault et al. (U.S. Patent No. 6,925,650).

CLAIMS 1, 2, 5, 7, 8, 9, 12, 14, 15, 16, 18, and 19

The rejection of independent claims 1 and 8 is not a proper *prima facie* case of obviousness as the combination of references proposed by the Examiner would not result in all of the limitations of claim 1.

The standard for a *prima facie* case of obviousness is the following:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. . . . *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

MPEP §2142 (8th edition, rev. 2, 2004)

In the present case, the Examiner has failed to establish a *prima facie* case of obviousness, as the cited references, even when combined, fail to teach or suggest all the limitations of claim 1.

Claim 1 and 8 each recite, inter alia:

“others of the at least two programs are also displayed under the dedicated channel directly in response to highlighting the only one of the at least two programs”

None of the references discloses this limitation. In particular, none of the references discloses display of additional programs “directly in response to highlighting the only one of the at least two programs.” The Examiner takes the position that Arsenault discloses a listing of similar programs displayed to a user as a direct result of a user highlighting a program and selecting an option, at col. 20, lines 13-17 (Advisory Action of 12/12/2005, Continuation Sheet). The Examiner’s characterization of Arsenault as requiring a user action of selecting after the user

action highlighting clearly shows that Arsenault does not teach the limitation in question.

Moreover, the Examiner's characterization is not complete, because, as explained below, Arsenault envisions two user actions in the step of "selecting an option."

Even the Examiner's own characterization of Arsenault demonstrates that his position is incorrect. Claim 1 recites that others of the programs are displayed "directly in response to highlighting the only one of the at least two programs." Thus, claim 1 requires that others of the programs are displayed directly in response to the single step of highlighting. By contrast, by the Examiner's characterization, Arsenault displays similar programs only as a result of a user (1) highlighting a program and (2) selecting an option. Thus, the Examiner characterizes Arsenault as teaching display after highlighting and a further action by a user, namely selecting an option, while claims 1 and 8 recite display directly in response to a *single* action by the user, namely highlighting. The claim language "directly in response to" rules out any intermediate user action, such as selecting an option, between highlighting and display. Thus, the Examiner's own characterization of Arsenault shows that no proper *prima facie* obviousness rejection of claim 1 has been made.

In fact, Arsenault teaches display of similar programs, if the user has selected category button 215E, only as a result of a user (1) highlighting a program, (2) highlighting an option from information window 214; and (3) pressing a button to select the option. The relevant portion of Arsenault commences at col. 19, lines 43-46, where it is stated: "FIG. 8 shows an electronic television program guide 200B, which is generally similar to the electronic television program guide 200B shown in Fig. 5, but includes some additional category buttons 215." The function of category buttons 215 is explained in connection with FIG. 5 as follows:

The information window 214 provides additional information about programs displayed in the grid 202. The type of information displayed in the information window 214 depends on which category button 215A-215C is

currently selected. Users select one of the category buttons 215A-215C using the remote control 138. As shown in FIG. 5, the "Description" category is selected. Therefore, when a particular program is selected from the grid 202 by the remote control 138, a description of that program is displayed in the information window 214.

Thus, depending on the category button which has been selected, various information is displayed in category window 214 upon highlighting of a program. The type of information displayed in category window 214 when category button 215E is selected, is explained as follows:

FIG. 9 shows a list of search options in information window 214, which are displayed when a user selects the category button 215E ("Find"). A user may scroll through the list of search options using the remote control 220.

The text pointed to by the Examiner follows in the next paragraph of col. 20:

"Selecting the second option ("Other programs similar to this one") from the information window 214 will cause the receiver 132 to display in the information window 214 a list of programs that are similar to the program currently highlighted in the grid 202."

The second option is in fact one from a list, which is displayed directly in response to highlighting a particular program. It is clear that the user may scroll through the list of search options, and may separately select one of the search options. Thus, in Arsenault, the additional program options are displayed, when category button 215E has been selected, and after the steps of highlighting of the program, the user scrolls to "Other programs similar to this one", and then selects that option. Thus, Arsenault does not teach display of others of the programs directly in response to highlighting of a program. Rather, Arsenault requires two additional steps between highlighting of a program and the display of additional programs.

The Examiner's reading of the phrase "directly in response to highlighting" as being met by Arsenault disregards the word "directly." "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970), *quoted in* MPEP §2143.03. Thus, the Examiner's reading violates the

requirement that all words in a claim must be considered. The term “directly” is an ordinary English word, with a clear meaning. Ordinary, simple English words whose meaning is clear and unquestionable, absent any indication that their use in a particular context changes their meaning, are construed to mean exactly what they say. *Chef America, Inc. v. Lamb-Weston, Inc.*, 358 F.3d 1371, 1372, 69 USPQ2d 1857 (Fed. Cir. 2004), *cited in* MPEP § 2111.01. Here, the meaning of “directly” is clear. The inclusion of the word “directly” means that the others of the programs are displayed in response to highlighting of a program, without the need for any intervening action by the user. The Examiner’s improper reading would render the phrase “directly in response to” having no meaning other than “after.”

The Examiner argues, in the Advisory Action, that “the current claim language does not require that the displaying step be solely based upon the highlighting of a program, only as a direct result of the highlighting.” In fact, the phrase “directly in response to” admits the possibility of requiring other user actions *preceding* the act of highlighting in order to result in the display, but excludes any other user action *after* the act of highlighting and preceding the display. The phrase “as a direct result of the highlighting” similarly excludes a requirement of any further user action after highlighting and preceding the display. *Arsenault*, as it requires additional user action after highlighting and prior to the display of additional programs, does not teach displaying “as a direct result of the highlighting.” Thus, while the Examiner’s statement that the claim language requires that the displaying be solely based upon the highlighting of a program is accurate, this statement does not support the Examiner’s improper reading of the limitation.

The Examiner further characterizes the limitation of “directly in response to highlighting” as “broad” in the Advisory Action. However, the Examiner’s position appears to simply disregard completely the term “directly.” This is improper, as merely characterizing a limitation as “broad”

does not permit wording in a claim to be disregarded. As with all other wording in a claim, the word “directly” must be considered in determining patentability.

“Although the PTO must give claims their broadest reasonable interpretation, this interpretation must be consistent with the one that those skilled in the art would reach.” *In re Cortright*, 165 F.3d 1353, 1358 (Fed. Cir. 1999). Those skilled in the art would certainly interpret the term “directly in response to” as ruling out any intermediate user action between highlighting and display.

Furthermore, “[t]he PTO's interpretation of claim terms should not be so broad that it conflicts with the meaning given to identical terms in other patents from analogous art.” *Id.* Other decisions have given the term “directly” a meaning consistent with that advanced by Applicant here. For example, the Court interpreted “directly contiguous standard layers” to mean having no additional layers between the contiguous layers, not even nucleation or sacrificial barrier layers. *Southwall Technologies, Inc. v. Cardinal IG Co.*, 54 F. 3d 1570, 1573 (Fed. Cir. 1995). Similarly, the present limitation means having no additional use actions between the highlighting and the display.

Claim language should be interpreted consistent with the specification:

“During examination, “claims . . . are to be given their broadest reasonable interpretation consistent with the specification, and . . . claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art.” *In re Bond*, 910 F.2d 831, 833 (Fed. Cir.1990).” Quoted in *In Re American Academy Of Science Tech Center*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). The portion of the specification relating to the “directly in response to” limitation reads as follows:

when a user highlights (using the directional keys on the remote) the first shown program 1301 for a time slot (e.g., 1:00), the system will overlay the rest of the matched programs 1302 in that time slot on the program guide 1300.

(page 7, lines 10-12). To read the “directly in response to” limitation consistently with the example from the specification, this limitation has the same meaning as overlaying, i.e., displaying additional programs when the user highlights one program. The phrase “*when* the user highlights . . ., the system *will* overlay,” like the phrase “directly in response to,” implies that there is no intermediate user action required. While this limitation is not restricted to the embodiment in the specification, the Examiner’s interpretation of “directly” as meaning “highlight and selecting” is inconsistent with the specification.

Separately from the reasons set forth above, claims 1 and 8 are allowable over the prior art of record as the rejection of claim 1 and 8, as the prior art fails to suggest the modification to the references proposed by the Examiner, and in particular, there is no motivation to modify Arai in view of Arsenault. In summary, Arai teaches at least one personal channel displayed in an EPG so that the user does not have to change channels, thereby presenting one or more selected best choices to the user, and simplifying the process of program selection for the user (Paragraph [0116]). Arsenault teaches providing the user with an option of being able to select a list of alternative programs (col. 20, lines 13-17). To modify Wehmeyer (as modified by Arai) in view of Arsenault, as proposed by the Examiner, would defeat the purpose of Arai of simplifying program selection by the user. Arsenault teaches display of a list of programs for a particular time slot, in contrast to Arai, which discloses the display of one program for each time slot for each personal channel, permitting the user to select a personal channel. Arai’s solution is more complicated for the user, by making additional options available, and significantly failing to provide one program for each time slot for each personal channel.

For at least the forgoing reasons, independent claims 1 and 8 are allowable.

CLAIMS 17 and 20

In addition to the reasons set forth above in connection with claims 1 and 8, dependent claims 17 and 20 are allowable, on the grounds that none of the references teaches all of the limitations of these claims. In particular, none of the references teaches the limitation “wherein the dedicated channel is always displayed at a predefined position in the program guide.” The Examiner takes the position, on page 6 of the Final Office Action of August 25, 2005, that Arai teaches this limitation in Fig. 6, stating that “the displayed dedicated channel must be at some predefined position.” However, Arai merely illustrates in Fig. 6 that “My Channel 1” and “My Channel 2” are, in this example, displayed on the right hand side of a program guide. Arai provides no explanation as to how this position is determined. Accordingly, there is no teaching or suggestion in Arai of the limitation “wherein the dedicated channel is always displayed at a predefined position in the program guide.”

Rejection of Claims 6 and 13 as being unpatentable under 35 USC 103(a) over Wehmeyer (U.S. Patent No. 5,867,226), in view of Arai, et al. (U.S. Publication No. 2002/0073425) Arsenault et al. (U.S. Patent No. 6,925,650) and Schein et al. (U.S. Patent No. 6,133,909.

CLAIMS 6 AND 13

Claims 6 and 13 depend respectively from claims 1 and 8, and are allowable for the reasons set forth above in connection with claims 1 and 8. In addition, claim 6 and 13 are allowable on the grounds that none of the references teaches or suggests the combination of “processing program guide information based on entered user processing request information and the viewing statistics” where the step of entering user processing request information comprises “selecting a search of program guide information based on user-entered text.” Rather, in Schein, the user may enter selected preferences by a means to input alpha-numeric characters (col. 12, lines 66 to col. 13, line 20). This embodiment, in Schein, is an *alternative* to another embodiment

disclosed in Schein, where, whenever the user watches a program a system searches for and marks all programs which may be of interest (Abstract). None of the references disclose processing program guide information based on the *combination* of viewing statistics and user-entered text.

For at least these reasons, claims 6 and 13 are allowable.

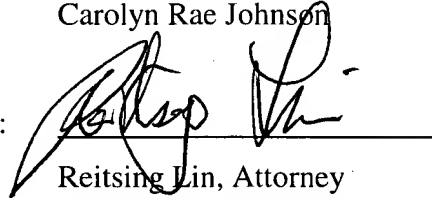
VIII CONCLUSION

Accordingly it is respectfully submitted that the rejection of Claims 1, 2, 5-9 and 12-20 should be reversed.

Respectfully submitted,

Carolyn Rae Johnson

By:

A handwritten signature in black ink, appearing to read 'Reitsing Lin', is written over a horizontal line.

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APPENDIX I - APPEALED CLAIMS

1 1. A method of processing program guide information, comprising the steps of:
2 recording viewing statistics based on topics;
3 entering user processing request information;
4 processing program guide information based on entered user processing request
5 information and the viewing statistics; and
6 displaying processed result, matching the topics in the recorded viewing statistics, in a
7 dedicated channel, wherein the processed result includes at least two programs in a first time slot,
8 only one of the at least two programs is displayed in the first time slot under the dedicated channel,
9 and others of the at least two programs are also displayed under the dedicated channel directly in
10 response to highlighting the only one of the at least two programs.

1 2. The method of claim 1 wherein the step of displaying processed result in a
2 dedicated channel further comprising the step of first arranging the processed result into
3 respective time slots.

1 5. The method of claim 1 wherein the step of entering user processing request
2 information comprising selecting a request for suggesting a program.

1 6. The method of claim 1 wherein the step of entering user processing request
2 information comprising selecting a search of program guide information based on user-entered
3 text.

1 7. The method of claim 1 wherein the dedicated channel is displayed along with other
2 channels in a program guide.

1 8. A system for processing program guide information, comprising:
2 a user controller for entering user processing request information;

3 a microprocessor for recording viewing statistics based on topics and for processing
4 program guide information based on entered user processing request information and the viewing
5 statistics; and

6 said microprocessor causing the processed result, matching the topics in the recorded
7 viewing statistics, to be displayed in a dedicated channel, wherein the processed result includes at
8 least two programs in a first time slot, only one of the at least two programs is displayed in the first
9 time slot under the dedicated channel, and others of the at least two programs are also displayed
10 under the dedicated channel directly in response to highlighting the only one of the at least two
11 programs.

1 9. The system of claim 8 wherein the microprocessor arranges the processed result
2 into respective time slots before the processed result is displayed.

1 12. The system of claim 8 wherein the entered user processing request information
2 comprises a request for suggesting a program.

1 13. The system of claim 8 wherein the entered user processing request information
2 comprises a request for a search of program guide information based on user-entered text.

1 14. The system of claim 8 wherein the dedicated channel is displayed along with other
2 channels in a program guide.

1 15. The system of claim 8, wherein the statistic of a topic is the number of times the
2 topic has been viewed.

1 16. The system of claim 8, wherein the statistic of a topic is the number of times the
2 topic has been viewed more than a predetermined time period.

1 17. The system of claim 14, wherein the dedicated channel is always displayed at a
2 predefined position in the program guide.

1 18. The method of claim 1, wherein the statistic of a topic is the number of times the
2 topic has been viewed.

1 19. The method of claim 1, wherein the statistic of a topic is the number of times the
2 topic has been viewed more than a predetermined time period.

1 20. The method of claim 7, wherein the dedicated channel is always displayed at a
2 predefined position in the program guide.



APPENDIX II - EVIDENCE

NOT APPLICABLE

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Signature Karen Scheuch

Date: 1-20-06

APPENDIX III - RELATED PROCEEDINGS

NONE

APPENDIX IV - TABLE OF CASES

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| <i>Chef America, Inc. v. Lamb-Weston, Inc.</i> , 358 F.3d 1371, 69 USPQ2d 1857 (Fed. Cir. 2004)..... | 7 |
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| <i>In re Vaeck</i> , 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)..... | 5 |
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| <i>Southwall Technologies, Inc. v. Cardinal IG Co.</i> , 54 F. 3d 1570 (Fed. Cir. 1995)..... | 9 |

APPENDIX V - LIST OF REFERENCES

| <u>U.S. Pat. No.</u> | <u>Issued Date</u> | <u>102(e) Date</u> | <u>Inventors</u> |
|-----------------------------|---------------------------|---------------------------|-------------------------|
| 5,867,226 | February 2, 1999 | | Wehmeyer et al. |
| 6,133,909 | October 17, 2000 | | Schein et al. |
| US2002/0073425 | June 13, 2002 | | Arai et al. |
| 6,925,650 | August 2, 2005 | | Arsenault et al. |

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